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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,754	07/03/2001	William E. Saltzstein	PHYS116783	5287

7590 08/29/2005

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EXAMINER

EVANISKO, GEORGE ROBERT

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Advisory Action**  
**Before the Filing of an Appeal Brief**

Application No.

09/898,754

Applicant(s)

SALTZSTEIN ET AL.

Examiner

George R. Evanisko

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 12 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: the arguments are not persuasive (please see the attached sheet).  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

George R Evanisko  
Primary Examiner  
Art Unit: 3762  
9/21/5

***Response to Arguments***

Applicant's arguments filed 8/12/05 have been fully considered but they are not persuasive. The argument that the Examiner and Applicant generally agree that there are significant differences between the structure and function of the system described by Morgan and the requirements of the Applicant's independent claims is not persuasive. The Examiner does not think there are significant differences, but that the differences are minor and obvious since it would have been obvious to substitute one conventional communication system (telephone, cellular, RF, etc) with another "conventional" communication system (point-of-presence, web site on a data network, etc.).

The argument that none of the cited references teaches or suggests a two-way communication network that includes a point-of-presence, wherein the two way communication network receives a communication from a remote monitoring service via the point-of-presence and a data network, "and sends a communication including an instruction to perform a status assessment of a defibrillator parameter to a portable defibrillator in response to receiving the communication from the remote monitoring service" is not persuasive since the Examiner is not relying on the other cited references for sending a communication including an instruction to perform a status assessment of a defibrillator. Morgan already contains this limitation. The Examiner is only relying on the other cited references for showing that it is obvious to substitute one conventional communication system for another conventional communication system.

The argument that the Examiner has not provided any teaching for a two way paging network is not persuasive since the Examiner provided several references, such as 5950632, to show the use of a two way paging network to transmit data for two way communications. In

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response to the applicant's argument regarding obvious design choice, it is noted that the systems of the prior art operate on basically the same principle and in the same manner as the applicant's device. Those limitations which applicant relies on provide no novel or unexpected results and use of such limitations in lieu of those used in the references solves no stated problem and would be an obvious matter of design choice within the skill in the art. (see *In re Kuhle*, 188 USPQ 7 and MPEP 2144.04).

The argument that the Examiner has failed to identify any suggestion or motivation with the prior art to modify Morgan in the manner necessary to arrive at the claimed invention is not persuasive since the Examiner provided this motivation. The Examiner stated that it would be obvious to include the point-of-presence (web site) on a data network to "easily and inexpensively receive data over a conventional communication system to allow the operator/physician to remotely access the data". The argument that the Applicant fails to see how communication with the modified Morgan is any easier or less expensive than communication via the Morgan system as originally described is not persuasive since the Examiner did not argue this. The Examiner is only stating that it would be obvious to modify one conventional communication system with another conventional communication system.

The argument that the Examiner did not indicate where this motivation may be found "within the prior art" is not persuasive. As stated in MPEP 2143.01 "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art". The test for an implicit showing is what the combined teachings,

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knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).". As stated in MPEP 2144, "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). See also In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (setting forth test for implicit teachings)". In addition, please see MPEP 2144.01 Implicit Disclosure. Also, it is not reasonable to suggest that every reference contain motivation for every element in that reference. For example, it is known that a capacitor is used to store and deliver energy, a door knob is used to open and close a door, and a web site on a data network is used to send and receive data from a remote location, and therefore the function of each item does not necessarily have to be listed in a reference.

The arguments are not persuasive. Morgan teaches one conventional communication system (telephone, RF, etc) to send an instruction to perform a status assessment of a defibrillator. The prior art cited (such as 5857967, 5715823, 6144922, 6141584, etc), the knowledge of one having ordinary skill in the art at the time the invention was made, and/or the general knowledge of the public since the 1990s have known or used point-of-presence (web site) on a data network to send and receive data. The substitution/modification of one

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conventional communication system as seen in Morgan with another conventional communication system (web site on a data network) would be obvious.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Evanisko whose telephone number is 571 272 4945.

The examiner can normally be reached on M-F 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571 272 4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
George R Evanisko  
Primary Examiner  
Art Unit 3762

8/26/5

GRE  
August 26, 2005